# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/520,576 | 03/08/2000 | Roland Vincent St. John Killick | 03628-0450 | 1427 |

| 29052 | 7590 | 09/23/2005 | | EXAMINER |
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| ART UNIT | PAPER NUMBER |
|---|---|
| 3622 | |

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

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# GROUP 3600

## BEFORE THE BOARD OF PATENT APPEALS
## AND INTERFERENCES

Paper No. 8/26/05

Application Number: 09/520,576
Filing Date: March 8, 2000
Appellant(s): Killick

William R. Silverio
For Appellant

## EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/21/05.

*(1)　Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

*(2)　Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

*(3)　Status of Claims*

The statement of the status of the claims contained in the brief is correct.

*(4)　Status of Amendments*

The Appellant's statement of the status of amendments contained in the brief is correct.

*(5)　Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

*(6)　Grounds of Rejection to be Reviewed on Appeal*

The Appellant's statement of the Grounds of Rejection to be Reviewed on Appeal in the

brief is correct.

*(7)　Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

## *(8)    Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims

under appeal.

| | | |
|---|---|---|
| 6,327,570 | Stevens | Feb, 2000 |
| POS News | What Grocers Want | May, 1991 |
| 6,321,208 | Barnett | Nov, 2001 |
| 6,024,288 | Gottlich | Feb, 2000 |

## *(9)    Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 34-40, 42-43, 46, 47, 50-60 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Stevens (6,327,570) in view of "What Grocers Want in Electronic Marketing

Programs" POS News, v.7, n.13, 5/91 and in view Barnett (6,321,208).

Stevens teaches a system for analyzing consumer data comprising: a computer program

for analyzing consumer data (col. 8, lines 5-15); a terminal device (col. 7, lines 35-55); and a

consumer data acquisition device that stores consumer data (col. 6, lines 1-15, col. 7, lines 25-

35); wherein the terminal device is operable to selectively extract at least a portion of the

consumer data stored on the consumer data device for analysis by the computer program (col. 19,

lines 1-40, col. 10, lines 35-45); the terminal device is operable to transmit consumer data to the

consumer device (col. 7, lines 35-60, col. 8, lines 50-65); the consumer data acquisition device

can at least be a barcode reader with memory, a digital computer, or a personal digital assistant

(col. 8, line 50 – col. 10, line 30); the terminal is positioned local to a point of sale terminal or a network terminal (col. 7, lines 35-45, col. 17, lines 5-45, col. 18, lines 5-15); the program resides in part at the consumer acquisition device (col. 10, lines 25-60) and a data collection center operable to identify consumer data for analysis where the computer program resides at least in part (col. 8, lines 1-35).

The article teaches selectively extracting consumer data for analysis and inferring information from the database (p. 1-2). It would have been obvious to one having ordinary skill in the art at the time of the invention to have selectively extracted information where the terminal cannot extract all of the customer data and inferred marketing information as taught in the article in the system of Stevens since this would have avoided the problems of gathering too much information as described in the article. It also would have been obvious to have cleared at least a portion of the consumer data from the consumer data device since this would have been adopted for the intended use of freeing limited memory of the user card for continued use of the card. It also would have been obvious to one having ordinary skill in the art to have modified the consumer data since this would have been adopted for the intended use of receiving the most up to date promotions as described in Stevens.

Barnett further discloses that said computer program is operable to analyze consumer data, said analysis further comprising filtering said consumer data (col 12, lines 25-65).

Barnett further discloses that the output of said analysis is an inferred marketing database (col 12, lines 25-65; Fig 10).

Barnett further discloses a computer program for analyzing computer data wherein said computer program is at least in part remote from said terminal device (Fig. 1; Fig. 8; col 12, line 65-col 13, line 10; col 13, line 50-col 14, line 6); and

A collection center, in communication with the terminal device (Fig. 1; Fig. 8; col 12, line 65-col 13, line 10; col 13, line 50-col 14, line 6), where the collection center instructs the terminal device to extract all of the consumer data from the consumer data acquisition device (col 5, lines 27-35; col 12, lines 30-36).

Barnett further discloses that different parts of consumer data can be utilized in analysis (col 12, lines 37-50). Therefore, it would have been obvious to Barnett to extract the information of interest.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's variably distributed information providing and analysis features to Stevens' analysis of consumer data. One would have been motivated to do this in order to more expansive and flexible options for consumer analysis.


Claims 34-40, 42, 43, 46, 47, 50-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gottlich (6,024,288) in view of "What Grocers Want in Electronic Marketing Programs" POS News, v.7, n.13, 5/91 and in view Barnett (6,321,208).

Gottlich teaches a system for analyzing consumer data comprising: a computer program for analyzing consumer data (col. 8, lines 45-60, col. 11, lines 35-65); a terminal device (PRW); and a consumer data acquisition device that stores consumer data (user card, col. 11, lines 55-65); wherein the terminal device is operable to selectively extract at least a portion of the

consumer data stored on the consumer data device for analysis by the computer program (col. 11,

line 50 – col. 12, line 15, col. 12, line 50 – col. 13, line 15); the terminal device is operable to

transmit consumer data to the consumer device (col. 8, lines 45-55); the consumer data

acquisition device is a magnetic medium (col. 6, lines 60-65, col. 7, lines 10-15); the terminal is

positioned local to a point of sale terminal or a network terminal (col. 11, lines 20-50); the

terminal device modifies consumer data from a memory of consumer data acquisition device

(col. 13, lines 5-15); the program resides in part at the terminal device (col. 12, lines 40-67, col.

14, lines 20-40) and a data collection center operable to identify consumer data for analysis

where the computer program resides at least in part (col. 11, line 45- col. 12, line 15).

The article teaches selectively extracting consumer data for analysis and inferring

information from the database (p. 1-2). It would have been obvious to one having ordinary skill

in the art at the time of the invention to have selectively extracted information where the terminal

cannot extract all of the customer data and inferred marketing information as taught in the article

in the system of Gottlich since this would have avoided the problems of gathering too much

information as described in the article. It also would have been obvious to have cleared at least a

portion of the consumer data from the consumer data device since this would have been adopted

for the intended use of freeing limited memory of the user card for continued use of the card

similar to clearing the memory of the PRW of Gottlich (col. 11, lines 60-65, col. 13, lines 5-10).

Barnett further discloses that said computer program is operable to analyze consumer

data, said analysis further comprising filtering said consumer data (col 12, lines 25-65).

Barnett further discloses that the output of said analysis is an inferred marketing database

(col 12, lines 25-65; Fig 10).

Barnett further discloses a computer program for analyzing computer data wherein said computer program is at least in part remote from said terminal device (Fig. 1; Fig. 8; col 12, line 65-col 13, line 10; col 13, line 50-col 14, line 6); and

A collection center, in communication with the terminal device (Fig. 1; Fig. 8; col 12, line 65-col 13, line 10; col 13, line 50-col 14, line 6), where the collection center instructs the terminal device to extract all of the consumer data from the consumer data acquisition device (col 5, lines 27-35; col 12, lines 30-36).

Barnett further discloses that different parts of consumer data can be utilized in analysis (col 12, lines 37-50). Therefore, it would have been obvious to Barnett to extract the information of interest.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's variably distributed information providing and analysis features to Gottlich's analysis of consumer data. One would have been motivated to do this in order to more expansive and flexible options for consumer analysis.

*(10)    Response to Argument*

Examiner notes that a 35 USC 103(a) rejection was made and that it is the combination of the prior art that renders the Appellant's claimed invention obvious. That is, each piece of prior art does not disclose all the Appellant's claimed features. Rather, the combination of prior art that renders the Appellant's claimed invention obvious. Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

*Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).


VII. A.

VII. A., 1. and 2.

On page 5 of the Appellant's Appeal Brief dated 3/21/05, Appellant states, "Although

Stevens discloses that a master control node can communicate with the data device, for instance

via a business or store unit, Stevens does not disclose or suggest that a remote collection center

dictate what information the terminal extracts from the data device."

Please note that Stevens discloses communication and data exchange between a central

source and a user device:

"(6) The docking station 55 allows the personal agent device 11 to down-load and upload

data from the communications message board 54. Total data synchronization is possible

between the two devices (col 6, lines 55-60);

(11) In this manner, large amounts of data can be exchanged between the business's

professional unit 9 and the consumer's personal agent 11 (col 7, lines 50-55);

(44) In addition, other encryption systems can be utilized for data security such as one-

time pad systems. Data encryption should always be used on any data involving money

transactions, private data such as medical data, and other sensitive data transfers. Encryption is

optional on general data transfers" (col 13, lines 55-64).

Stevens further discloses the value of user information for marketing or targeting

purposes:

"(12) The central control node or master node processor 3 would have the capability of

performing complex statistical analysis of consumer business data and product sales

information (records of sales from various participating businesses) to predict trends,

target specific interested consumers in special products or promotions, or provide feedback to

participating businesses on the success or failure of various advertising or promotions" (col 8,

lines 8-15).

On page 6, Appellant states, "However, What Grocers Wants does not disclose or suggest

an external collection center that is in active communication with a terminal device such as a

Point of Sale (POS) terminal, where the collection center instructs the terminal to extract all or

part of the consumer data from the consumer data acquisition device."

However, "What Grocers Want" discloses that that a POS system is utilized, "Decisions

by Citicorp POS Information Services. . ." (page 1), and that selective data is acquired from the

customer, "They also want control over what customer data is collected and where that

information goes. What they don't want is more data then they can use and they don't want to

lose control of that data" (page 1) and "That was too much data for the retailer to make sense of.

. .Instead of tracking every purchase. . .Bass says the system has the ability to offer a simplified

frequent shopper program" (page 2). "What Grocers Want further discloses that the user utilizes

a consumer data acquisition device such as a magnetic medium, a magnetic medium having

memory, a bar code reader, "After all it is the retailer that collects this information. When a

participating customer presents his card to the clerk, the merchant matches up the bar code

readings. . ." (page 1) . "What Grocers Want" further discloses, "MAC last month introduced a

proprietary check authorization/debit card that a frequent shopper program can be built around. .

." (page 2).

Therefore, "What Grocers Want" discloses obtaining select data concerning a user's

activities and also that the user can utilize devices (POS or card) for user activities.

On page 7, in regards to Barnett, Appellant states, "However, that language merely

describes that a central repository may receive information from the online service provider as to

the coupons downloaded by users, and that individual stores may also provide redemption

information to the central repository. Thus, there is no active solicitation or extraction in Barnett

of data on a consumer device."

On Page 7, Appellant states, "None of the recited references disclose, teach, or suggest

that a collection center can dictate what information is selectively extracted from a consumer

device."

On page 8, Appellant states, "In fact, in Barnett there is no discussion of a consumer data

acquisition device from which information may be extracted. In marked contrast to the claimed

present invention, all of the information received by the central repository in Barnett is from the

online service provider or store. There is no consumer device, nor is there the extraction of

consumer data from the device. Additionally, to the extent the Examiner may interpret the

consumer device to be the user's computer, there is no data extracted from the user's computer,

nor is there any extraction of information on the computer by a terminal device. Therefore, like

Stevens and What Grocers Want, there is not disclosure or teaching by Barnett of a collection

center in communication with a terminal device, where the collection center instructs the

terminal device to extract either all or only a selective part of consumer data from a consumer

data acquisition device, as required by the independent claims."

However, Barnett's Fig. 1 discloses that Coupon Request and User Data (Fig. 1, item 4)

can go from the Personal Computer (Fig. 1, item 6) to the Online Service Provider. Barnett

discloses that Online Service Distributor, Coupon Distributor, Coupon Redemption Database can

be distinct (as in Fig. 1) or that they can be the same centralized entity:

"(41)   In accordance with the present invention, the marketing analysis, coupon

packaging, and coupon package distribution functions carried out by the coupon distributor 16

may be carried out at the central data repository, i.e. Internet web site. Further, the coupon

redemption and user redemption information processing functions individually carried out by

the coupon redemption center 13 and the individual retail stores 10 may be combined into a

single redemption center, as shown by the dotted line in FIG. 1. The physical layout of the

functions within the system of the present invention is a matter a practicality and choice of the

systems designer and does not impact the utility of the present invention (col 12, line 65-col 13,

line 10);

(47)   In another alternative embodiment of the present invention, all coupon data

management functions are carried out by the online service provider 2 rather than by the offline

coupon data management routines 32" (coll 3, line 63-col 14, line 2).

Barnett discloses in Fig. 2 that the data that can go back and forth between the user

device (Fig. 2 is the 'remote personal computer' of the user also called the user device) and the

collection center ("To/From Online Service") and that the data can be selected coupon data (Fig.

2, item 30b), user specific data (Fig. 2, item 30d), or shopping list data (Fig. 2, item 32g).

Barnett discloses that the computer or device of the user can take many forms such as being a mobile or wireless device (Fig. 8, item 94, item 20)

Barnett discloses that there is data exchange between the central controller and the user device of a wide variety of data:

"A centrally located repository, such as an online service provider or web site on the Internet, stores packages of coupon data for downloading on demand to the user's computer. The user may view, select, sort and print desired coupons from the downloaded package. The user's demographic as well as coupon selection data is provided back to the online service and coupon distributor and issuers for subsequent marketing analysis(Abstract);

(36) In the present invention, the data exchange capabilities provided by the transmission medium between the remote computer and the central repository allow the automatic transfer of valuable information from the remote computer to the central repository and, ultimately, to the coupon distributing and issuing centers. Information related to the coupons selected and printed can be supplied to the coupon distributors and issuers, which can also use information obtained from the various retail stores as to which coupons were actually redeemed in order to more intelligently market subsequent coupons and target coupon issuance in a more cost effective manner (col 5, lines 21-35);

(26) The coupon upload routine 32cc is called automatically and without user request whenever the user requests a coupon download package from the online service provider 2. A record is kept by the upload routine 32cc indicative of each coupon selected by the user and each coupon printed by the user. This record is sent to the demographic data file 42 in the

online service provider 2, and is used for marketing analysis along with data regarding which

coupons were actually redeemed, which information is obtained from the manufacturers'

redemption agency or center" (col 10, lines 47-57).

Barnett's Fig. 9 discloses that user data and product data is provided from a user device

to a central center for analysis purposes (Fig. 9, 'Obtain User Data and Product Data', 'Analyze

Data to Determine Subsequent Coupon Sets').

Notice in Barnett that any of User Data, Product Data, user demographic information,

user coupon selection information, etc. are stored on the user device, can be extracted from the

user device, and that this information can be uploaded from the user device to a central

controller.

Additionally, Barnett discloses active solicitation of user data from a user who is utilizing

a consumer device (col 7, line 62-col 8, line 5). Note that in this citation that the data the user

enters is entered into the user device and then goes from the user device to the central

controller. Also, note that user logging on (Fig. 4a; col 8, lines 43-48; col 14, lines 16-19)

involves receiving user data from the user device where the data can be the user name and/or

password that is entered into the user device and then sent from the user device to the central

controller.

Hence, contrary to Appellant's statements above, Barnett does disclose active solicitation

or extraction of data on a consumer device, that a collection center can dictate what information

is selectively extracted from a consumer device; a consumer data acquisition device from which

information may be extracted; a consumer device, the extraction of consumer data from the

device; data extracted from the user's computer, extraction of information on the computer by a

terminal device; extracting all or only a selective part of consumer data from a consumer data

acquisition device.

Hence, "What Grocers Want" provides further features and motivation to Stevens for

obtaining some or all information on a user's activities. Barnett discloses that a variety of user

information can be obtained from a user device and that this information can be analyzed for

targeting purposes.

Hence, the features of the Appellant's independent claim are rendered obvious by the

combination of Stevens, "What Grocers Want", and Barnett.


VII. A. 3.

Beginning on page 9, Appellant states that there is not motivation to combine the cited

references.

In response to applicant's argument that the examiner's conclusion of obviousness is

based upon improper hindsight reasoning, it must be recognized that any judgment on bviousness

is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes

into account only knowledge which was within the level of ordinary skill at the time the claimed

invention was made, and does not include knowledge gleaned only from the applicant's

disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170

USPQ 209 (CCPA 1971).

In terms of the motivation to combine the prior art, Examiner notes that each of the prior

art provides relevant features to tracking or recording user purchasing or behavior at POS

systems for the purpose of targeting a user. Hence, each prior art provides further capabilities or

features towards these mutual objectives. Please see the motivation statement in the Final

Rejection for the specific reason for combining each prior art.


VII. B.

VII. B., 1. and 2.

On page 11, Appellant states that the features cited above as lacking in the Stevens,

"What Grocers Want" and Barnett reference are also lacking in the Gottlich, "What Grocers

Want", and Barnett reference.

However, like Stevens, Gottlich discloses communication and data exchange between a

central source and a user device:

"The processing means also transfers data read from the card which identifies the user

along with data relating to the current transaction into a storage means within the PRW, where it

is saved in data processing retrievable format for later transport to a central database. Because

the information on a user's card is kept current at all times, the user may go immediately from

one system site to another with the system at all locations being capable of responding based on

up-to-the-minute user information. There is no delay in responding to a user's most recent

transactions while waiting for the system to batch the current data, upload it to a central site,

and download it again to other sites within the system.

(35) Although communication with an external source is not required to complete an

interaction with a user, a means of communication may be desirable to further enhance the

system of the present invention. According to one embodiment, a communication means is

provided such that the system may transfer and/or receive data such as a user's personal or

purchasing history, promotional offers, or updates to software resident in the PRW" (col 8, lines

27-57).

Gottlich further discloses the value of user information for marketing or targeting

purposes:

"(1)  BACKGROUND OF THE INVENTION

(2)  A. Field of the Invention

(3)  The present invention relates to an affordable, yet effective, system and apparatus

for determining, upon request, an appropriate personalized and individually-targeted response

for a particular user based upon current user-specific data with real-time delivery of that

response to the user in non-volatile, re-writable visual format" (col 1, lines 10-18).

Please see the analysis above concerning the "What Grocers Want" and the Barnett

reference to see how the features stated by the Appellant as lacking the combination of the prior

art are rendered obvious by the combination of Gottlich, "What Grocers Want", and Barnett.


VII. B. 3.

Beginning on page 15, Appellant states that there is not motivation to combine the cited

references.

Please see the above section VII. A. 3. to see the response concerning the motivation to

combine the prior art.

VII. C.

Concerning the rejection of the dependent claims, please see the citations from the Final

Rejection above. Examiner further notes that Appellant has not stated what features the

Appellant believes are not disclosed by the combination of the prior art. Examiner further notes

that while specific references were made to the prior art, it is actually also the prior art in its

entirety and the combination of the prior art in its entirety that is being referred to.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

April 26, 2005
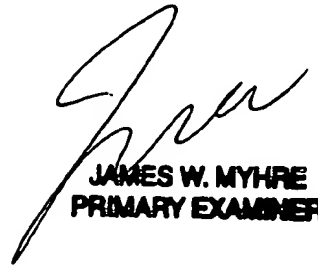
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